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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,894	07/03/2002	Shinichiro Nagata	MTS-3322US	2753
7590	11/29/2005		EXAMINER	
Allan Ratner Ratner & Prestia One Westlakes Berwyn Suite 301 PO Box 980 Valley Forge, PA 19482-0980			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 11/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,894

Applicant(s)

NAGATA ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 37-40, 55 and 81-94 is/are pending in the application.
- 4a) Of the above claim(s) 55 and 81-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03112002, 05202004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-14, 37-40, 55 and 81-94 are presented for examination.
2. Claims 55 and 81-94 have been withdrawn from consideration.
3. Claims 1-14 and 37-40 are pending in this Office Action.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

6. Claims 37-40 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 37-40 recite the same claim limitations found in claims 1-4 from which they depend upon.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-14 and 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how “after a predetermined time duration for *causing* said user to terminate said telephone call,” a user could then register a change of email address if the user is no longer connected to the system. Appropriate correction is required.

9. Claims 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend upon method claims while claims 37-40 recite “a computer-processable medium carrying a program for causing a computer to execute.” The claim does not allow one to ascertain which statutory category the dependent claims are a part of. It is thought that Applicant meant to define claims 37-40 as independent claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 6-9, 11-14 and 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato (U.S. 6,961,409).

12. With respect to claim 1, Kato teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Kato, Fig. 3; col. 5, line 30 – col. 6, line 15); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Kato, col. 3, lines 41-49); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for causing the user to notify an e-mail address (Kato, col. 7, lines 37-44); when the telephone number of the caller is determined as registered, after a predetermined time duration for causing the user to terminate the telephone call (Kato, col. 3, lines 41-55), carrying out registration change guidance for causing the user to notify a new e-mail address for registration change (Kato, col. 7, lines 37-44); and when the user has terminated the telephone call before the elapse of

the predetermined time duration, searching the data base on the basis of the telephone number of the caller, and thereby transmitting e-mail information to the obtained e-mail address (Kato, col. 4, line 54 – col. 5, line 4).

13. With respect to claim 2, Kato teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Kato, Fig. 3; col. 5, line 30 – col. 6, line 15); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Kato, col. 3, lines 41-49); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for causing the user to notify an e-mail address (Kato, col. 7, lines 37-44); when the telephone number of the caller is determined as registered, after a predetermined time duration for causing the user to terminate the telephone call (Kato, col. 3, lines 41-55), carrying out registration change guidance for causing the user to notify a new e-mail address for registration change (Kato, col. 7, lines 37-44); and when the telephone number of the caller is determined as registered, regardless of whether the registration change guidance has not yet begun, has already begun, or has already completed, when the user has terminated the telephone call, searching the database on the basis of the telephone number of the caller, and thereby transmitting e-mail information to the obtained e-mail address (Kato, col. 4, line 54 – col. 5, line 4).

14. With respect to claim 3, Kato teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Kato, Fig. 3; col. 5, line 30 – col. 6, line 15); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Kato, col. 3, lines 41-49); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for causing the user to notify an e-mail address (Kato, col. 7, lines 37-44); when the telephone number of the caller is determined as registered, after a predetermined time duration for causing the user to terminate the telephone call (Kato, col. 3, lines 41-55), carrying out registration change guidance for causing the user to notify a new e-mail address for registration change (Kato, col. 7, lines 37-44); and when the telephone number of the caller is determined as registered, and when the registration change guidance is guidance for causing the user to notify a new e-mail address for registration change during the voice communication of the telephone call, if the new e-mail address for registration change is not yet notified at the time when the user has terminated the telephone call, searching the data base on the basis of the telephone number of the caller and thereby transmitting e-mail information to the obtained e-mail address (Kato, col. 3, lines 53-62), in contrast, if the new e-mail address for registration change is already notified at the time when the user has terminated the telephone call, not transmitting the e-mail information to the e-mail address older than the notified e-mail address (Kato, col. 7, lines 37-44).

15. With respect to claim 4, Kato teaches an information distribution method comprising the steps of:

Generating a database for corresponding telephone numbers and e-mail addresses to each other, in advance (Kato, Fig. 3; col. 5, line 30 – col. 6, line 15); on receiving a telephone call from a user, searching the database on the basis of the telephone number of the caller of the telephone call, and thereby determining whether the telephone number of the caller is registered or unregistered (Kato, col. 3, lines 41-49); when the telephone number of the caller is determined as unregistered, carrying out initial registration guidance for causing the user to notify an e-mail address (Kato, col. 7, lines 37-44); when the telephone number of the caller is determined as registered, without any predetermined time duration for causing the user to terminate the telephone call (Kato, col. 3, lines 41-55), carrying out registration change guidance for causing the user to notify a new e-mail address for registration change (Kato, col. 7, lines 37-44); when the telephone number of the caller is determined as registered, and when the user has terminated the telephone call, searching the database on the basis of the telephone number of the caller, and thereby transmitting e-mail information to the obtained e-mail address (Kato, col. 4, line 54 – col. 5, line 4); and when the telephone number of the caller is determined as registered, and when the registration change guidance is guidance for causing the user to notify a new e-mail address for registration change during the voice communication of the telephone call (Kato, col. 3, lines 53-62), if the new e-mail address for registration change is already notified at the time when the user has terminated the telephone call, not transmitting the e-mail information to the e-mail address older than the notified e-mail address (Kato, col. 7, lines 37-44).

16. Claims 6-9, 11-14, and 37-40 do not teach or define any new limitations above claims 1-4 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato and further in view of Dosani et al. (U.S. 6,529,591).

Kato teaches the invention substantially as claimed including a caller's telephone number and an electronic mail address is associated with a caller's telephone number are registered with a telephone directory. If an incoming call is made to telecommunication terminal equipment and a response cannot be made, then an electronic mail is automatically transmitted to the electronic mail address (see Abstract).

19. With respect to claim 5, Kato teaches the invention described in claim 1, including an information distribution method where:

E-mail information is transmitted depending on the telephone numbers of the telephone destinations (Kato, col. 4, line 54 – col. 5, line 4).

Kato does not explicitly teach storing an association between the telephone number of the caller of the telephone call and the telephone number of the telephone destination in a database.

However, Dosani teaches when there are a plurality of telephone destinations and, at each time when any one of the telephone destinations receives a telephone call from the user, the telephone number of the caller of the telephone call and the telephone number of the telephone destination having received the telephone call are stored in a form corresponded to each other in a second database for a predetermined time duration (Dosani, col. 3, line 64 – col. 4 line 8); and when the telephone number of the caller is determined as unregistered, and when the e-mail address has been already notified according to the predetermined method on the basis of the guidance, the telephone number of the telephone destination corresponding to the telephone number corresponding to the notified e-mail address is identified by searching the second database (Dosani, col. 7, lines 1-17), whereby e-mail information depending on the telephone number of the telephone destination is transmitted to the notified e-mail address (Dosani, col. 8, lines 35-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kato in view of Dosani in order to enable storing an association between the telephone number of the caller of the telephone call and the telephone number of the telephone destination in a database. One would be motivated to do so in order to avoid long-distance and/or airtime charges that would occur if the called independent system had to answer a call made from a client to obtain its identification information.

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20. Claim 10 does not teach or define any new limitations above claim 5 and therefore is rejected for similar reasons.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
November 23, 2005


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER